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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shell Trademark Management, B.V.

Serial No. 78155768

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Esq. of Shell Oil Company for Shell Trademark Management,
B.V.

Glenn Clark, Trademark Examining Attorney, Law Office 115
(Tomas Vlcek, Managing Attorney).

Before Seeherman, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Shell Trademark Management, B.V. has filed an
application to register on the Principal Register the mark
ONBOARD for the following goods¹:

¹ Serial No. 78155768, filed August 20, 2002, based on an allegation of a bona fide intention to use the mark in commerce, under Section 1(b) of the Trademark Act. The application included a claim of priority, under Section 44(d) of the Trademark Act, based on the filing of a Benelux trademark application on March 21, 2002, which matured into Benelux Registration No.0713929. On August 8, 2003, applicant withdrew its Section 1(b) basis and is proceeding under Section 44(e) of the Trademark Act, based on its Benelux registration.

"chemical agents for testing oil and lubricants, namely testing the water content of oil and its viscosity," in International Class 1;

"apparatus and equipment for testing oil and lubricants, namely a portable kit comprised of test tubes and a pump," in International Class 9; and

"instructional manuals and booklets relating to the testing of oils and lubricants, namely, testing the water content of oil and its viscosity," in International Class 16.

The examining attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The examining attorney contends that ONBOARD is merely descriptive in connection with applicant's goods because "onboard" is defined as "carried aboard a vehicle or vessel"² and "carried within or occurring aboard a vehicle (as a satellite or spacecraft)"³; applicant's goods are used to test the water content and viscosity of oil on board vessels; and ONBOARD "is commonly used in the relevant industry to name and describe the feature of oil analysis test kits and equipment that are carried onboard a vehicle

² *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

³ *Merriam-Webster Online Dictionary*, www.m-w.com, March 16, 2004.

or vessel [for] 'onboard' testing and analysis of oil, fuel and other lubricants on ships and vessels [and] has become a necessary part of ongoing maintenance." (Brief, p. 4.) In support of his position, the examining attorney submitted, in addition to dictionary definitions of "onboard," copies of excerpts from Internet web sites of purported competitors "using the word 'onboard' or 'on-board' to describe the uses of their competing oil analysis and testing goods and related services." (*Id.*) The following excerpts are representative examples of this evidentiary submission (emphasis added):

[www.navsea.navy.mil] The following initiatives will significantly reduce ship's force maintenance man-hours as well as the life cycle costs of these systems and equipment ...:

. . .

Automated **On Board** Oil Analysis: COTS automated monitoring for in line wear debris and oil quality will replace the current labor intensive oil analysis (combination of **onboard** testing and ashore lab analysis).

[www.lubmarine.com] TECH'CARE/PRO - The **on board** analysis system designed by Lubmarine for increased monitoring of machinery between DIAGOMAR PLUS analyses.
TECH'CARE/PRO, through the use of simple techniques, enables the condition of machinery and lubricants to be checked **on board** the vessel whenever desired.

[www.fluidtec.com/newsletter] "Ruler Newsletter"
During the last LOAP International Condition Monitoring 2002 conference, April 8-10, the paper entitled *Development and Laboratory Evaluation of **On-Board** Oil Condition Monitoring Sensors for*

HMMWV Diesel Engines was presented by Bob Kauffman, University of Dayton Research Institute.

[www.kittiwake.com] Site title: "Kittiwake: Water Testing Solutions and Fuel & Lube Oil Testing. Title of link on site map: "**Onboard** Test Kit."

. . .

[Kittiwake's] core business is providing fuel and lube oil sampling kits for the maritime industry. These are kits which can test out fuel and lube oil **onboard** vessels themselves and kits for taking samples of oils, which can then be tested in laboratories on shore.

[www2.exxonmobil.com] ... Over the years Mobilgard and Exxmar have built a powerful reputation for customer support. For instance, both offer **onboard** lube test kits to help customers with engine maintenance. The brands also provide shoreside programs for analyzing used oil for signs of engine wear. ...

[www.marinelog.com] ... The "Feed Rate Optimization" program is designed to help minimize operating expenses by analyzing scrapedown oil as a way to detect changes in the condition of an engine's cylinders.

. . .

It provides comprehensive laboratory testing and analysis of the oil sample, and offers **onboard** testing tools that enable ship's engineers to quickly detect substantive changes in cylinder condition.

. . .

Onboard testing augments and complements the more comprehensive Signum laboratory testing with supplementary reports that are especially useful because they provide key results in a matter of seconds.

Applicant contends that the mark is suggestive and not merely descriptive because it does not immediately convey

any quality or characteristic of the goods. Applicant makes the following statement (Brief, p. 7):

The goods are portable, and thus movable from place to place. However, it is not necessary the goods be placed, carried, or stored in a vehicle or vessel. They might be stored in a vehicle/vessel, or they might be stored in a warehouse, or any other safe environment. It is at the discretion of the user of the goods. Furthermore, the goods are primarily chemicals and testing apparatus. The fact that the oil testing itself is conducted on/within/inside the engine of the vessel does not thereby make the mark ONBOARD descriptive of the chemicals themselves or the apparatus itself used to conduct the test.

In support of its position, applicant submitted an excerpt from its Internet web site, a portion of which is shown below, explaining the nature of its products:

[www.shell.com/marine] Shell **Onboard** Plus - This extensive kit tests five important parameters of lubricating oil performance including water in oil, insoluble material TBN, viscosity, and salt water contamination.

. . .

Shell **Onboard** - This simple test kit provides ship engineers with on-the-spot information about the condition of lubricants on board ship. It can be used to quickly test the water in oil and viscosity.

Applicant also submitted copies of third-party registrations for the mark ONBOARD "for goods that could arguably be used to carry out tasks while 'on board' a vessel" (Brief, p. 8)⁴; and copies of third-party registrations for the marks

⁴ The word ONBOARD is registered for a variety of goods and services, including, for example, vacuum pumps and related goods (Registration No. 1905334), personnel payroll scheduling software, especially for shipboard personnel (Registration No. 2091825), and luggage (Registration No. 1370158). Registration No. 2463283 for

ONDECK and ONSITE for goods that applicant asserts are likely to be used, respectively, on decking and at a particular site. Applicant contends that these are analogous marks that are not merely descriptive.

Applicant also argues that ONBOARD "has a dual idiomatic meaning ... [of] 'on the job,'"⁵ (Brief, p. 11) and, thus, is a registrable double entendre.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).



for yacht chartering and sailing instruction services includes a disclaimer of ONBOARD. Applicant also submitted excerpts from an Internet web site to show that vacuum pumps are used to pump sludge, etc., from a ship's tanks.

⁵ *The American Heritage Dictionary of the English Language*, 4th ed, and *The Cambridge International Dictionary of Idioms*.

Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); see also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

Applicant's goods are identified broadly and encompass the specified products for testing oil and lubricants in any context where such tests are relevant. The excerpt from applicant's web site shows that these goods are presently used to test oil and lubricants used onboard ships and other vessels. Further, the excerpt shows that the chemical agents and instruction manuals and booklets identified in International Classes 1 and 16, respectively, are used in connection with the portable test kits identified in International Class 9; that the oils and lubricants tested are those used onboard a ship or other vessel; and that the testing is conducted onboard a ship or other vessel.

The evidence submitted by the examining attorney shows that it is the usual practice to periodically test the oil and other lubricants used in connection with machinery

onboard vessels; that such testing is divided between samples tested at laboratories ashore and samples tested onboard the ship or other vessel; and that the testing conducted onboard a ship is commonly referred to as "onboard testing." Thus, ONBOARD merely describes a type of testing of shipboard oils and lubricants that occurs "onboard" the ship or vessel, signifying where the identified goods are used.⁶

We are not persuaded otherwise by applicant's arguments. For example, neither the fact that the goods are portable and may be "stored anywhere," nor the fact that the testing is conducted "on/within/inside the engine" overshadow the fact that the goods are used for "onboard testing." Similarly, applicant's allegation that "onboard" also means "on the job," is not supported by any evidence that applicant touts the goods in relation to this secondary meaning or that the relevant public would so perceive the term in the context of the identified goods. Finally, the third-party registrations submitted by applicant are not determinative of the question of registrability of

⁶ This case is somewhat analogous to the case of *In re Central Sprinkler Company*, 49 USPQ2d 1194 (TTAB 1998). The Board affirmed the refusal to register on the Supplemental Register the word ATTIC for "automatic sprinklers for fire protection." The Board stated: "The simple fact is that the only evidence of record ... relating to applicant's particular sprinklers indicates that the sprinklers at issue are for placement and use in one place, that is, in the attic. ... Upon encountering the term ATTIC for sprinklers, the relevant public surely would understand the term primarily to refer to a sprinkler for the attic, that is, an 'attic sprinkler.'"

applicant's mark. It is well settled that each case must be taken on its own facts. *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991); and *In re Inter-State Oil Co., Inc.*, 219 USPQ 1229, 1231 (TTAB 1983).

When applied to applicant's goods, the term ONBOARD immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely that the chemical agents and portable kits may be used onboard a vessel to conduct the identified tests and that the subject matter of the instruction manuals and booklets is these chemical agents and portable kits. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term ONBOARD as it pertains to those goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.